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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,383	03/26/2004	Mathias Sonneck	07781.0160-00	7611
60668 7590 07/09/2008 SAP / FINNEGAN, HENDERSON LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER BAIRD, EDWARD J				
ART UNIT 3693		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/809,383

**Applicant(s)**

SONNEK ET AL.

**Examiner**

EDWARD BAIRD

**Art Unit**

3693

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-28 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 25 February 2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Applicant has amended claims 1, 5, 7 – 9, 13, 15 – 17, 21, and 23 - 24. Claim 6 has been canceled; new claims 25 – 28 have been added. Thus, claims 1 – 5 and 7 – 28 are pending in this application.

### ***Response to Arguments***

1. Applicant's arguments and amendments filed on 25 February 2008 with respect to rejections of claims 1, 7, 8, 9, 16, 17, 23, and 24 under 35 USC § 112, 2<sup>nd</sup> paragraph, claims 1 – 5 under 35 USC § 101, and rejections of claims 1 – 24 under 35 USC § 103(a), have been fully considered.
2. Examiner agrees with amendments to claims 1, 5, 7, 8, 9, 16, 17, 23, and 24 in order to overcome rejections under 35 USC § 112, 2<sup>nd</sup> paragraph, to overcome rejections under 35 USC § 101, and to further clarify the invention. Accordingly, Examiner withdraws rejections.
3. Applicant requested that Examiner consider Non-Patent Literature Document filed at USPTO on 25 February 2008. Document is written in German. While Examiner is knowledgeable in the German language, material does not appear to affect the evaluation on the US Patent application and is in turn disregarded.
4. Applicant's arguments filed on 25 February 2008 with respect to rejections of claims 1 – 24 under 35 U.S.C. 103 (a) (**Koppes in view of O'Shaughnessy**) have been fully considered but moot in view of new grounds of rejection.

***Specification***

5. Applicant cooperation is requested in correcting any error of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. **Claim 25** recites the limitation "the automatic formation of the intermediate variable" in "wherein the automatic formation of the intermediate variable from the book value and the market value further comprises automatically calculating an intermediate variable". There is insufficient antecedent basis for this limitation in the claim. It is unclear if "the automatic formation of the intermediate variable" is the same as "automatically forming an intermediate variable" due to different terminology.

For purposes of examination, the term "the automatic formation of the intermediate variable" will be interpreted to mean "automatically forming an intermediate variable". Appropriate correction is required.

9. **Claim 27** recites the limitation "displaying a calculated impairment price". There is insufficient antecedent basis for this limitation in the claim.

For purposes of examination, the term "displaying a calculated impairment price" will be interpreted to mean "a calculated impairment price is displayed". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1 – 5, 9 – 14, and 17 – 22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Brown, et al** (USPub. No. 2002/0059127).

12. Regarding **claim 1**, **Brown** teaches:

- automatically determining, by a processor, a book value for each object in an accounting system [see at least 0018 and 0031. Examiner interprets *cost basis or then present value of each individual security* as analogous to Applicant's **book value**. Examiner notes that because rebalancing, tax loss harvesting, and trading functions are performed automatically by computerized systems [0018], automatically determining the book value is inherent in his method].
- automatically determining a market value for each object [0033].
- automatically forming an intermediate variable from the book value and the market value [0033. Examiner interprets *current index value* as analogous to Applicant's **intermediate variable**];

- automatically testing the intermediate variable to determine whether it satisfies one or more presettable conditions [0042 and 0043. Examiner interprets *tax loss harvesting process* as including Applicant's **automatically testing the intermediate variable**]; and
- automatically sending a message to a person [see at least 0053] depending upon the manner or degree to which one or more of the presettable conditions are satisfied [see at least 0047 and 0048. Examiner interprets *the rebalance accounts step* as analogous to Applicant's **satisfied presettable conditions**].

13. Regarding **claims 2, 10, and 18, Brown** teaches balance sheet objects as securities [see at least 0013 to 0017].

14. Regarding **claim 3, 11, and 19, Brown** teaches the market value as the price of the object multiplied by the number of units available [see at least 0041 to 0043].

15. Regarding **claims 4, 12, and 20, Brown** teaches the intermediate variable as a difference between the book value and the market value [see at least 0034. Examiner interprets the difference between *the present market value* and *the stored historical cost value* as analogous to Applicant's **intermediate variable**].

16. Regarding **claims 5, 13, and 21, Brown** teaches presettable condition as the disparity between the intermediate value and a maximum disparity for the intermediate variable [see at least 0034. Examiner interprets *predetermined loss threshold* as analogous to Applicant's **maximum disparity for the intermediate variable**] ascertained over a settable period of time by a presettable amount [see at least 0041].

17. **Claim 9** is a system claim substantially similar to the method of claim 1, and is thus rejected for the same reasons. Note, however, that claim 9 has fewer limitations than claim 1 (i.e. it is broader than claim 1) and is therefore covered by the rejection of claim 1.

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18. Regarding **claims 14 and 22**, **Brown** teaches sending a message to a person [see at least 0053].
19. **Claim 17** is an apparatus claim substantially similar to the method of claim 1, and is thus rejected for the same reasons. Note, however, that claim 17 has fewer limitations than claim 1 (i.e. it is broader than claim 1) and is therefore covered by the rejection of claim 1.
20. Claim 7, 8, 15, 16, and 23 – 26 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Brown** in view of **Fickes** (USPub. No. 2005/0262014).
21. Regarding **claim 7**, **Brown** teaches:
- the impairment price as a market price for the object [see at least 0034. Examiner interprets *present market value of each security* as analogous to Applicant's **impairment price**].
- Brown** does not explicitly disclose displaying values.
- However, **Fickes** discloses a system and method for defining values of corporations by its categories of values, and determining risk profiles accordingly [Abstract]. These values include Category I -- Current Realizable Value, Category II -- Value of Existing Business, Category III -- Infrastructure Value, and Category IV -- Venture Value. Categories II through IV represent values over (or under) Category I [see at least 0073 to 0081]. **Fickes** further discloses displaying values of the "metrics" for a company. Examiner interprets these *metrics* as being inclusive of Applicant's **impairment price** as a market price (*Category I -- Current Realizable Value*).
- Therefore, it would have been obvious to a person having an ordinary skill in the art at the time of **Brown's** invention to include *displaying an impairment price as a market price* as

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taught by **Fickes** because it allows a user to the user to build a logical set of criteria for defining a peer group by specifying [sic] lower and upper boundaries for any number of metrics [**Fickes** 0133].

Examiner notes the **impairment price** is only applicable to the claim 1, the independent claim, when the “displaying a calculated impairment price” option is chosen. Examiner *may* choose to interpret claim 1 **not** for “displaying a calculated impairment price” option in which case the Examiner can interpret this claim (i.e. claim 7) as not further limiting. However, Examiner interprets claim 1 as limited to displaying a calculated impairment price for this prior art rejection.

22. Regarding **claim 8**, **Brown** does not explicitly disclose:

- the impairment price as a market price for the object increased or reduced by a presettable value, and
- displaying a calculated impairment price (if this limitation is chosen in claim 1 as discussed in the rejection of claim 7).

**Brown** does not explicitly disclose displaying values.

However, **Fickes** discloses a system and method for defining values of corporations by its categories of values, and determining risk profiles accordingly [Abstract]. These values include Category I - - Current Realizable Value, Category II – Value of Existing Business, Category III – Infrastructure Value, and Category IV –Venture Value. Categories II through IV represent values over (or under) Category I [see at least 0073 to 0081]. **Fickes** further discloses displaying values of the “metrics” for a company. Examiner interprets these *metrics* as being inclusive of Applicant’s **impairment price** as a market price for the object increased or reduced by a presettable value as in *Categories II through IV* discussed herein.

Therefore, it would have been obvious to a person having an ordinary skill in the art at the time of **Brown's** invention to include *displaying an impairment price as a market price for the object increased or reduced by a presettable value* as taught by **Fickes** because it allows a user to the user to build a logical set of criteria for defining a peer group by specifying [sic] lower and upper boundaries for any number of metrics [**Fickes** 0133].

Examiner notes the **impairment price** is only applicable to the claim 1, the independent claim, when the "displaying a calculated impairment price" option is chosen. Examiner *may* choose to interpret claim 1 **not** for "displaying a calculated impairment price" option in which case the Examiner can interpret this claim (i.e. claim 8) as not further limiting. However, Examiner interpreted claim 1 as limited to displaying a calculated impairment price for this prior art rejection.

23. **Claims 15 and 16** are system claims parallel to the methods of claims 7 and 8, respectively, and are thus rejected for the same reasons.

Note that these system claims are dependent on claim 14 in which the **impairment price** is only applicable when the "calculating an impairment price" option is chosen. Examiner *may* choose to interpret claim 14 **not** for "calculating an impairment price" option in which case the Examiner interprets these claims (i.e. claims 15 and 16) as not further limiting.

24. **Claims 23 and 24** are apparatus claims parallel to the methods of claims 7 and 8, respectively, and are thus rejected for the same reasons.

Note that these apparatus claims are dependent on claim 22 in which the **impairment price** is only applicable when the "calculating an impairment price" option is chosen. Examiner *may* choose to interpret claim 22 **not** for "calculating an impairment price" option in which case the Examiner can interpret this claim (i.e. claim 7) as not further limiting.

25. Regarding claim 25, **Brown** teaches:

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- automatically determining, by a processor, a book value for each object in an accounting system;
- automatically determining a market value for each object;
- automatically forming an intermediate variable from the book value and the market value;
- automatically testing the intermediate variable to determine whether it satisfies one or more presettable

as discussed in the rejection of claim 1. **Brown** also teaches:

- automatic formation of the intermediate variable from the book value and the market value further comprises automatically **calculating an intermediate variable** [see at least 0033. Examiner interprets *current index value* as analogous to Applicant's **intermediate variable**];
- automatically testing the intermediate variable to determine whether it satisfies one or more presettable conditions is testing the disparity between the intermediate variable and an average value for the intermediate variable ascertained [see at least 0033 and 0034. Examiner interprets *stored historic cost value* as analogous to Applicant's **average value for the intermediate variable**]
- . . . over a settable period of time by a presettable amount [see at least 0032 to 0034. Examiner interprets *predetermined loss threshold* as analogous to Applicant's **presettable amount**].

**Brown** does not explicitly disclose:

- displaying a calculated impairment price.

However, **Fickes** discloses a system and method for defining values of corporations by its categories of values, and determining risk profiles accordingly [Abstract]. These values

include Category I -- Current Realizable Value, Category II -- Value of Existing Business, Category III -- Infrastructure Value, and Category IV -- Venture Value. Categories II through IV represent values over (or under) Category I [see at least 0073 to 0081]. **Fickes** further discloses displaying values of the “metrics” for a company [00134]. Examiner interprets these *metrics* are being inclusive of Applicant’s **impairment price**.

Therefore, it would have been obvious to a person having an ordinary skill in the art at the time of **Brown’s** invention to include *displaying an impairment price* as taught by **Fickes** because it allows a user to build a logical set of criteria for defining a peer group by specifying [sic] lower and upper boundaries for any number of metrics [**Fickes** 0133].

26. Regarding **claim 26**, **Brown** teaches sending a message to a person [see at least 0053].

27. Claim 27 is rejected under 35 U.S.C. 103 (a) as being unpatentable over **Brown** in view of **Fickes** in further view of **Adhikari** (USPub. No. 2004/0158479).

28. Regarding **claim 27**, neither **Brown** nor **Fickes** explicitly disclose:

- a calculated impairment price is displayed comprises drawing attention to the manner and degree to which the presettable conditions are satisfied by means of a screen icon.

However, **Adhikari** discloses methods and systems for calculating business valuations and using iterative processes to generate a maximum business value based on conditions and requirements of interested parties [0002]. He further discloses the use of a “best value” icon which generates and displays an optimized value representing required Buyer Equity [see at least 0060, 0069, 0076, and 0083]. Examiner interprets *Buyer Equity* as analogous to Applicant’s **impairment price**.

Therefore, it would have been obvious to a person having an ordinary skill in the art at the time of **Brown's** invention to include *using a "best value" icon to generate and display optimized values* as taught by **Adhikari** because it allows a user maximum versatility in determining the factors most critical to a transaction and in calculating the best value of part of a transaction [**Adhikari** 0086].

29. Claim 28 is rejected under 35 U.S.C. 103 (a) as being unpatentable over **Brown** in view of **Fickes** in further view of **Adhikari** and **Official Notice**.

30. Regarding **claim 28**, neither **Brown**, **Fickes**, or **Adhikari** explicitly disclose:

- displaying a calculated impairment price further comprises **displaying the difference between an amortized acquisition value of the object and an impairment value** of the object

However, **Fickes** discloses determining *Category I, II, III, and IV values* [see at least 0073 to 0082] and displaying related "metric" values [00134]. **Fickes** defines Category III - - Infrastructure values are defined as "the discounted value of expected future cash flows from business which can reasonably be expected to be produced in future years, from new sales" [0079]. Examiner interprets this "*discounted value*" as analogous to Applicant's **amortized acquisition value**. Although **Fickes** does not explicitly disclose the "*difference*" between the **amortized acquisition value and an impairment value of the object**, it would have been obvious to one skilled in the art at the time of **Fickes** disclosure to include the difference in that it would show a user the disparity between determined "values" for a business.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Baird whose telephone number is (571) 270-3330. The examiner can normally be reached on Monday - Thursday 7:30 am - 5:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

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would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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